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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/814,293

04/01/2004

Paul Stark

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06/03/2009

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EXAMINER

PALENIK, JEFFREY T

ART UNIT

PAPER NUMBER

1615

MAIL DATE

DELIVERY MODE

06/03/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/814,293</p>	<p>Applicant(s) STARK ET AL.</p>	
	<p>Examiner Jeffrey T. Palenik</p>	<p>Art Unit 1615</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 26 May 2009. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-32.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: The amendment to claim 1 would be persuasive enough to overcome the rejections as discussed below (see Comments to 5). However, said amendment and affidavits will not be entered on the record because the proposed amended claim raises new issues not previously addressed and would necessitate a new search. Furthermore, the amendment to claim 1 is viewed by the Examiner as adding new matter to the claimed invention particularly since the scope of what is claimed is broader in scope and therefore not commensurate in scope with what is supported by the original disclosure.

Continuation of 5. Applicant's reply has overcome the following rejection(s): As noted in 3(a), the amendment made to claim 1 and Exhibits/Affidavits A-C, were they to be entered on the record, would result in the following actions:

Rejection under 35 USC 112

Applicants' amendment to claim 1 removing the broad limitation of "Eudragit polyacrylic acid" as well as removing the tradename "Eudragit" from the claim, if entered, would be sufficient to render moot the rejection to claims 1-32, under 35 USC 112, second paragraph, thereby resulting in the withdrawal of the rejection.

Rejection under 35 USC 103(a)

Applicants' amendment to claim 1, Exhibits/Affidavits A-C, and the remarks, if entered, would be sufficient to render moot the rejection to claims 1-32, under 35 USC 103(a) as being unpatentable over Noda et al. (USPN 5,137,733) in view of Oshlack et al. (USPN 5,580,578), thereby resulting in the withdrawal of the rejection.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' amendment to independent claim 1, which removes the limitation "Eudragit polyacrylic acid, Eudragit S, [and] Eudragit L" and replaces it with "anionic polymers of methacrylic acid that dissolve at a pH of 5.5 to 7", broadens the scope of the claim. The present recitation is interpreted by the Examiner as claiming ANY anionic polymer of methacrylic acid that dissolves at a pH of 5.5-7. The support provided by Applicants' remarks is not sufficient to support this amendment. Eudragit polyacrylic acid was interpreted in the previous action as being a broader genus category under which different species of Eudragit were categorized (i.e. Eudragit L, S, RL, RS, etc.). Thus, while Applicants' amendment does the art currently made of record, it also more critically broadens the scope of the independent claim, thereby adding new matter to the claimed invention, and thus necessitates a new/additional search by the Examiner..

/Jeffrey T. Palenik/
Examiner, Art Unit 1615

/MP WOODWARD/
Supervisory Patent Examiner, Art Unit 1615